IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Michael Gilfix, *et al.*	§	Group Art Unit: 2423
	§	
	§	Examiner: Thomas, Jason M.
Serial No.: 10/687,239	§	
	§	Atty Docket No.: AUS920030360US1
Filed: 10/16/2003	§	
	§	Customer No.: 34533
Title: Interactive, Non-intrusive Television Advertising	§	
	§	Confirmation No.: 8992

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF

Honorable Commissioner:

This is an Appeal Brief filed pursuant to 37 CFR § 41.37 in response to the Final Office Action of September 15, 2009 (hereinafter the "Office Action"), and pursuant to the Notice of Appeal filed December 15, 2009.

REAL PARTY IN INTEREST

The real party in interest in accordance with 37 CFR § 41.37(c)(1)(i) is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences within the meaning of 37 CFR § 41.37(c)(1)(ii).

STATUS OF CLAIMS

Status of claims in accordance with 37 CFR § 41.37(c)(1)(iii): Forty-two (42) claims are filed in the original application in this case. Claims 1, 3, and 5-14 are rejected in the Office Action. Claims 1, 3, and 5-14 are on appeal. Claims 2, 4, and 15-42 were previously cancelled.

STATUS OF AMENDMENTS

Status of amendments in accordance with 37 CFR § 41.37(c)(1)(iv): No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims that accompanies this Appeal Brief.

SUMMARY OF CLAIMED SUBJECT MATTER

Appellants provide the following concise summary of the claimed subject matter according to 37 CFR § 41.37(c)(1)(v). This summary includes a concise explanation of the subject matter defined in each of the independent claims involved in the appeal and includes references to the specification by page and line number and to the drawings by elements. The independent claim involved in this appeal is claim 1. Claims 1 is a method claim.

Claim 1 recites a method for delivering interactive non-intrusive advertising content (page 18, lines 11-12; Figure 3). The method of claim 1 includes receiving a selection signal indicating that a user has selected an item displayed on a television screen, the item included in the television program being displayed, wherein the item has associated non-intrusive interactive advertising content (page 18, lines 11-17; Figure 3, elements 302, 304, and 310). The method of claim 1 also includes responsive to receiving the selection signal, identifying the selected item (page 20, lines 18-19; Figure 3, elements 306 and 316). The method of claim 1 also includes displaying the associated non-intrusive interactive advertising content (page 21, lines 3-4; Figure 3, element 308). The method of claim 1 also includes receiving and storing advertising data that associates the selected

item with a screen region and with interactive advertising content, the advertising data encoded in a digital stream separate from a video signal and synchronized with movement in a video display displaying the video signal, wherein receiving the advertising data comprises receiving the data stream through a digital network (page 21, lines 19-22, and Figure 3, elements 320 and 324).

GROUNDS OF REJECTION

In accordance with 37 CFR § 41.37(c)(1)(vi), Appellants provide the following concise statement for each ground of rejection:

1. Claims 1, 3, and 5-10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Katchner, et al. (U.S. Patent No. 7,120,924).

2. Claims 11-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Katchner, et al. (U.S. Patent No. 7,120,924) in view of Wistendahl, et al. (U.S. Publication No. 2002/0056136).

ARGUMENT

Appellants present the following argument pursuant to 37 CFR § 41.37(c)(1)(vii) regarding the ground of rejection on appeal in the present case.

Argument Regarding The First Ground Of Rejection On Appeal: Claims 1, 3, And 5-10 Stand Rejected Under 35 U.S.C. § 102(e) As Being Anticipated By Katchner, Et Al. (U.S. Patent No. 7,120,924)

Claims 1, 3, and 5-10 stand rejected under 35 U.S.C. § 102 as being anticipated by Katchner, et al. (U.S. Patent No. 7,120,924) (hereafter 'Katchner'). Appellants respectfully submit that Katchner does not anticipate the claims of the present application because Katchner does not disclose every element and limitation recited in the claims of the present application. For example, Katchner does not disclose "receiving and storing advertising data that associates the selected item with a screen region and with interactive advertising content, the advertising data encoded in a digital stream separate from a video signal and synchronized with movement in a video display displaying the video signal, wherein receiving the advertising data comprises receiving the data stream through a digital network," as recited in independent claim 1.

In contrast to claim 1, Katchner describes a system and method of receiving information (including advertising content) hyperlinked to a television broadcast. *See*, Katchner at the Abstract. Katchner states that information is hyperlinked into a television broadcast through the use of an authoring tool. *See*, Katchner at column 4, lines 49-54. The authoring tool is used to combine video data from a video source with encoded data representing the information that is hyperlinked into the video data to form a single augmented transport stream. *See*, Katchner at column 4 line 65 – column 5, line 9. The cited reference does not disclose "receiving and storing advertising data that associates the selected item with a screen region and with interactive advertising content, the advertising data encoded in a digital stream separate from a video signal and synchronized with movement in a video display displaying the video signal, wherein receiving the advertising data comprises receiving the data stream through a digital

network," as recited in claim 1, because Katchner does not disclose advertising data that is encoded in a digital stream separate from a video signal. Katchner repeatedly discloses that video data and encoded data representing the information that is hyperlinked into the video data are combined to form a single augmented data stream. For example, Katchner at column 6, lines 5-9, states that "[t]he encoded video data from the video encoder 36 is combined with the encode data packet stream 27 from the data packet stream generator 40 in a multiplexer 44 and the resulting augmented transport stream 46 is input into the multiplexer system 48." That is, Katchner describes combining the two types of data (video data and packet data) to form a single stream – not advertising data encoded in a digital stream separate from a video signal and synchronized with movement in a video display displaying the video signal, as claimed here.

In the Response to Argument section of the Office Action, the Examiner indicates that "while Katchner only teaches a single transport stream, containing both the video signal and the advertising data... the advertising data is encoded in a digital stream separate from the video signal... where PIDs are used to identify multiple elementary stream contained within the transport stream in the MPEG2 standard." Applicants respectfully note in response, however, that the existence of packet identifiers does not therefore imply that Katchner discloses that advertising data is encoded in a digital stream that is separate from a video signal and synchronized with movement in a video display displaying the video signal. The packet identifiers disclosed in Katchner are used to identify the type (e.g., video or data) of content in a particular packet. The existence of packet identifiers does not mean that advertising data and video data are encoded in separate streams. In fact, the packet identifiers are only necessary because advertising data and video data are not encoded in separate streams. That is, packet identifiers of the type described in Katchner would be unnecessary if advertising data and video data were encoded in separate streams, as all data in the video stream would be video data and all data in advertising stream would be advertising data. Packet identifiers are necessary for all packets in Katchner's single augmented stream only because advertising data and video data are combined into a single stream, thereby creating the need to distinguish between packets containing different types of data that are within a single stream.

Because Katchner does not disclose every element and limitation recited in claim 1 of the present application, Katchner does not anticipate claim 1. Claims 3 and 5-10 depend from claim 1. For at least the same reasons that Katchner does not anticipate claim 1, Katchner also cannot anticipate claims 3 and 5-10. Appellants respectfully request that the rejection of claims 1, 3, and 5-10 therefore be withdrawn and that the claims be allowed.

Argument Regarding The Second Ground Of Rejection On Appeal: Claims 11-14 Stand Rejected Under 35 U.S.C. § 103(a) As Being Unpatentable Over Katchner, Et Al. (U.S. Patent No. 7,120,924) In View Of Wistendahl, Et Al. (U.S. Publication No. 2002/0056136)

Claims 11-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Katchner in view of Wistendahl (U.S. Publication No. 2002/0056136) (hereafter 'Wistendahl'). Claims 11-14 depend from claim 1. As explained above, Katchner does not teach or suggest every element and limitation recited in claim 1. Wistendahl cannot cure the deficiency of Katchner because Wistendahl also does not teach or suggest "receiving and storing advertising data that associates the selected item with a screen region and with interactive advertising content, the advertising data encoded in a digital stream separate from a video signal and synchronized with movement in a video display displaying the video signal, wherein receiving the advertising data comprises receiving the data stream through a digital network," as recited in independent claim 1.

In contrast to claim 1, Wistendahl describes converting existing media content to interactive media content by defining hot spots in a display frame of TV program content to trigger an interactive response when a viewer clicks on the hot spots. *See*, Wistendahl at the Abstract. Wistendahl states that a user's interaction with television content can be sent to advertisers so that the advertisers may follow up with the user regarding the user interaction. Wistendahl, however, does teach or suggest receiving and storing advertising data that associates the selected item with a screen region and with interactive advertising content, the advertising data encoded in a digital stream separate from a video signal and synchronized with movement in a video display displaying the video signal, wherein

receiving the advertising data comprises receiving the data stream through a digital network, as claimed here as there is no synchronization between the two separate streams of content of claim 1 – video content and advertising content.

Claims 11-14 depend from claim 1. For at least the same reasons that Katchner and Wistendahl do not teach or suggest every element and limitation of claim 1, Katchner and Wistendahl cannot possibly teach or suggest every element and limitation recited in claims 11-14. Appellants respectfully request that the rejection of claims 11-14 therefore be withdrawn and that the claims be allowed.

Conclusion of Appellants' Arguments

Claims 1, 3, and 5-10 stand rejected under 35 U.S.C. § 102 as being anticipated by Katchner. As shown above, Katchner does not disclose every element of Applicants' claims. Katchner therefore does not anticipate Applicants' claims. Claims 1, 3, and 5-10 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1, 3, and 5-10.

Claims 11-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Katchner in view of Wistendahl. The combination of Katchner and Wistendahl does not teach or suggest each and every element of Applicants' claims. Claims 11-14 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 11-14.

In view of the arguments above, reversal on all grounds of rejection is requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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APPENDIX OF CLAIMS
ON APPEAL IN PATENT APPLICATION OF
MICHAEL GILFIX, ET AL., SERIAL NO. 10/687,239

CLAIMS

What is claimed is:

1. A method for delivering interactive non-intrusive advertising content, the method comprising:

receiving a selection signal indicating that a user has selected an item displayed on a television screen, the item included in the television program being displayed, wherein the item has associated non-intrusive interactive advertising content;

responsive to receiving the selection signal, identifying the selected item; and

displaying the associated non-intrusive interactive advertising content;

receiving and storing advertising data that associates the selected item with a screen region and with interactive advertising content, the advertising data encoded in a digital stream separate from a video signal and synchronized with movement in a video display displaying the video signal, wherein receiving the advertising data comprises receiving the data stream through a digital network.

2. (Canceled)

3. The method of claim 1 wherein receiving the advertising data comprises receiving the advertising data encoded in a video signal that includes a video image of the item.

4. (Canceled)

5. The method of claim 2 wherein the advertising data includes instructions for control of the display of interactive non-intrusive advertising content for the item.

6. The method of claim 1 further comprising:

receiving one or more designation signals, wherein each designation signal represents an instruction to designate an item having associated non-intrusive interactive advertising content;

responsive to receiving each designation signal, designating singly, as a currently designated item, each of a multiplicity of items having associated non-intrusive interactive advertising content;

wherein identifying the selected item comprises identifying as the selected item the currently designated item.

7. The method of claim 6 wherein designating singly each of a multiplicity of items further comprises logically designating an item and visually designating an item.

8. The method of claim 7 wherein logically designating an item comprises setting a designation data element in advertising data for the item.

9. The method of claim 7 wherein visually designating an item comprises displaying descriptive text for the item.

10. The method of claim 7 wherein visually designating an item comprises changing a video display of the item.

11. The method of claim 1 further comprising tracking a cursor position on the

television screen, wherein identifying the selected item comprises identifying the selected item in dependence upon the cursor position when the selection signal is received.

12. The method of claim 1 wherein identifying the selected item in dependence upon the cursor position further comprises determining whether the cursor position is within a screen region associated with the item.

13. The method of claim 1 wherein the interactive advertising content comprises a web page describing the item and offering an on-line sale of the item.

14. The method of claim 1 wherein displaying the associated non-intrusive interactive advertising content comprises downloading a web page from a remote web site identified in a link associated with the selected item.

15–42. (Canceled)

APPENDIX OF EVIDENCE ON APPEAL IN PATENT APPLICATION OF MICHAEL GILFIX, ET AL., SERIAL NO. 10/687,239

This is an evidence appendix in accordance with 37 CFR § 41.37(c)(1)(ix).

There is in this case no evidence submitted pursuant to 37 CFR §§ 1.130, 1.131, or 1.132, nor is there in this case any other evidence entered by the examiner and relied upon by the Appellants.

RELATED PROCEEDINGS APPENDIX

This is a related proceedings appendix in accordance with 37 CFR § 41.37(c)(1)(x). There are no decisions rendered by a court or the Board in any proceeding identified pursuant to 37 CFR § 41.37(c)(1)(ii).